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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
GREENE, DANIEL L	
ART UNIT	**PAPER NUMBER**
3621	

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/671,643	ABBURI, RAJASEKHAR	
	Examiner	Art Unit	
	Daniel L. Greene	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *82,85,86,88,89 and 91-97* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *82,85,86,88,89 and 91-97* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The reply filed on 6/29/2005 is not fully responsive to the prior Office Action because the Applicant failed to provide support for the claim of the crediting of the first customer according to the count in the sub-entry. It appears the Applicant canceled the specific claim (90) that had that limitation and incorporated the claim of crediting the first customer according to the accumulated count into the currently amended independent claims 82 and 96. Review of the REMARKS does not provide the requested information of the last Office Action i.e. the page and line number in the Specifications where support for the claim is provided.

It would appear that the Applicant has acquiesced to the Examiner's position that the Specification does not support providing the portions of payments to the first customer based on the accumulated count.

Further, the statement " crediting the first customer according to ..." implies there is incremental crediting. The Specifications do not appear to teach what the increments are and how they are established.

Response to Arguments

1. Applicant's arguments filed 6/29/2005 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are

based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The Applicant submits that the Examiner's argument of inherency as set forth in the ***Response to Arguments*** of the previous Office Action should be withdrawn in the connection with the present Section 103 rejection. The Examiner submits that the Section 103 rejections are proper because obviousness was presented not inherency. The term "inherency" was used in reference to the discussion of the evidence supporting the Section 103 rejection and not used in the actual Section 103 rejection. The Examiner submits that if the term inherency were used in the Section 103 rejection, the Applicant's argument would be proper and correct. Since the term inherency was not used in the Section 103 rejection, the Applicant's argument is not applicable.

The Applicant submits that Schull reference does disclose it would be advantageous to offer purchasers a commission on sales derived from their own purchased copy of a given product. But then argues that, " The Schull reference does not recognize that a first customer might be awarded an incentive based on a purchase by a second customer as derived from such first customer" Page 12 of 17, last Para. A reference is to be considered not only for what it expressly states, but also for what it would reasonably have suggested to one of ordinary skill in the art. *In re DeLisle, 160 USPQ 806 (CCPA 1969).* The Examiner submits that the modifier "first', "second" is nonfunctional descriptive material and are not functionally involved in the steps recited. The awarding of the incentive steps would be performed the same regardless of whether the customer was the first, second, third, etc. Thus, this descriptive material will

not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to offer purchasers a commission on sales derived from their own purchased copy of a given product whether they were the first, second, third, etc, customer because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Claims 82, 85, 86, 88, 89 and 91-97 are pending in the present application.

DETAILED ACTION

1. Claims 82, 85, 86, 88, 91, 93, and 96-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schull, U.S. Patent 6,266,654 (Schull), and further in view of Koppelman et al. U.S. Patent 6,662,164 [Koppelman].

As per claims 82, 85, 88, and 96:

The recitation that the method comprising performing a plurality of transactions, each transaction comprising, has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a method, a system, an apparatus, etc. and the portion of the claim following the

preamble is a self-contained description of the method or the system, etc., not depending for completeness upon the introductory clause. *Kropa v. Robie, 88 USPQ 478 (CCPA 1951)* .

Schull discloses:

the licensor receiving a first license request for a first license from a first customer in connection with the content and issuing a first license in response thereto, the first customer having received a copy of the content from the retailer, the first request including retailer information associated with the corresponding piece of digital content and identifying the retailer; Col. 7, lines 1-10.

the licensor receiving a payment from the first customer in connection with the first license request. Col. 7, lines 1-10.

the licensor retrieving the retailer information from the first license request and identifying the retailer therefrom; Col. 7, lines 30-60.

the licensor crediting the identified retailer for a portion of the payment received in connection with the first license request; Col. 7, lines 30-60.

the licensor receiving a second license request for a second license from a second customer in connection with the content and issuing a second license in response thereto, the second customer having received a copy of the content from the first customer, the second request including first customer information associated with the corresponding piece of digital content and identifying the first customer; the licensor receiving a payment from the second customer in connection with the second license request; Col. 7, lines 30-60.

the licensor retrieving the first customer information from the license request and identifying the first customer therefrom; Col. 7, lines 30-60.

Schull discloses the claimed invention except for the licensor crediting the first customer for a portion of the payment received in connection with the second license request. However, Schull does disclose offering purchasers a commission on sales derived from their own purchased copy of a given product. Col. 7, lines 30-35. Koppelman teaches that it is known in the art to provide a commission for creating sales. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the offering to purchasers a commission on sales derived from their own purchased copy of a given product of Schull with the method and apparatus for determining a commission of Koppelman, in order to provide the ability to promote sales and determine Commissions and amounts payable to sales representatives.

Schull discloses the claimed invention except for wherein crediting the first customer comprises recording the first customer information in a database for accounting purposes, the database including an entry for each first customer information, each entry including a count for counting the number of times a license has been issued for the specific first customer information combination, such recording comprising: finding the first customer information entry in the database corresponding to the first customer information of the second request, or creating such sub-entry if none is present; and incrementing the count in such entry. However,

Schull does disclose offering purchasers a commission on sales derived from their own purchased copy of a given product. Col. 7, lines 30-35.

Koppelman teaches that it is known in the art to provide wherein crediting the first customer comprises recording the first customer information in a database for accounting purposes, the database including an entry for each first customer information, each entry including a count for counting the number of times a license has been issued for the specific first customer information combination, such recording comprising: finding the first customer information entry in the database corresponding to the first customer information of the second request, or creating such sub-entry if none is present; and incrementing the count in such entry. Fig. 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the offering to purchasers a commission on sales derived from their own purchased copy of a given product of Schull with the method and apparatus for determining a commission of Koppelman, in order to provide the ability to determine Commissions and amounts payable to sales representatives.

Schull discloses the claimed invention except for the whereby over the plurality of transactions the count in the entry is accumulated and the method comprising providing the portions of the payments to the first customer based on the accumulated count. However, Schull does disclose offering purchasers a commission on sales derived from their own purchased copy of a given product. Col. 7, lines 30-35. Koppelman teaches that it is known in the art to provide wherein crediting the identified

first customer comprises crediting the first customer according to the count in the entry. Col. 7, lines 12-22.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the offering to purchasers a commission on sales derived from their own purchased copy of a given product of Schull with the method and apparatus for whereby over the plurality of transactions the count in the entry is accumulated and the method comprising providing the portions of the payments to the first customer based on the accumulated count in the entry of Koppelman, in order to provide the ability to promote sales and determine Commissions and amounts payable to sales representatives.

As per claims 86 and 89:

Schull discloses the claimed invention except for wherein crediting the first customer comprises recording the first customer information in a database for accounting purposes, the database including an entry for each first customer information, each entry including a count for counting the number of times a license has been issued for the specific first customer information combination, such recording comprising: finding the first customer information entry in the database corresponding to the first customer information of the second request, or creating such sub-entry if none is present; and incrementing the count in such entry. However, Schull does disclose offering purchasers a commission on sales derived from their own purchased copy of a given product. Col. 7, lines 30-35.

Koppelman teaches that it is known in the art to provide wherein crediting the first customer comprises recording the first customer information in a database for accounting purposes, the database including an entry for each first customer information, each entry including a count for counting the number of times a license has been issued for the specific first customer information combination, such recording comprising: finding the first customer information entry in the database corresponding to the first customer information of the second request, or creating such sub-entry if none is present; and incrementing the count in such entry. Fig. 6.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the offering to purchasers a commission on sales derived from their own purchased copy of a given product of Schull with the method and apparatus for determining a commission of Koppelman, in order to provide the ability to determine Commissions and amounts payable to sales representatives.

As per claims 91 and 93:

Schull further discloses:

wherein receiving the second license request comprises receiving the second license request as addressed to a site identified by a site identifier, the site identifier including the content distribution information attached thereto, and wherein retrieving the content distribution information comprises retrieving the content distribution information as attached to the site identifier. Col. 7, lines 1-20.

As per claim 97:

Schull further discloses:

wherein the second customer is not the first customer. Col. 7, lines 30-60.

2. Claim 92 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schull and Koppelman as applied to claims 82-91 above, and further in view of Krishnan et al. U.S. Patent 6,073,124 [Krishnan].

Schull discloses the claimed invention except for the issuing the license to the second customer. Krishnan teaches that it is known in the art to issuing the license to the second customer. Fig. 4, Col. 9-10, lines 1-67.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the vending system of Schull with the issuing the license to the second customer of Krishnan in order for the new customer to utilize the purchased software and to prevent pirating of the software.

3. Claims 94 and 95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schull and Koppelman as applied to claims 82-91 above, and further in view of Powell, U.S. Patent 2001/0032189 A1 [Powell].

As per claim 94:

4. Schull and Koppelman discloses the claimed invention except for the wherein the payment comprises a non-monetary payment. Powell teaches that it is known to have barter transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use non-monetary transactions as taught by Powell, since Powell states at Para. 0196, that not all transactions require the transfer of money from user to originator.

As per Claim 95:

Schull and Koppelman discloses the claimed invention except for wherein the payment is selected from a group consisting of earned credits, barter chits, a promise to perform a function, and combinations thereof. Powell teaches that it is known to have barter transactions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use earned credits, barter chits, a promise to perform a function and combinations thereof to conduct non monetary transactions as taught by Powell, since Powell states in Para. 0196, that not all transactions require the transfer of money from user to originator and, a

user may propose to employ originator or to perform services in exchange for the right to use the originators FDI (license).

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 571-272-6707. The examiner can normally be reached on M-Thur. 8am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel L. Greene
Examiner
Art Unit 3621

PRIMARY EXAMINER

8/23/2005